APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,586	05/25/2006	Makoto Kawasaki	287710US8PCT	5562

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EXAMINER
SONG, JASMINE

ART UNIT	PAPER NUMBER
2189	

NOTIFICATION DATE	DELIVERY MODE
09/14/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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		Application No.	Applicant(s)
Office Action Summary		10/580,586	KAWASAKI, MAKOTO
		Examiner	Art Unit	
		JASMINE SONG	2189	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>25 May 2006</u>.
2a) ☐ This action is FINAL.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-17</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-17</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on <u>25 May 2006</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☒ All   b) ☐ Some * c) ☐ None of:
        1. ☒ Certified copies of the priority documents have been received.
        2. ☐ Certified copies of the priority documents have been received in Application No. _____.
        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>5/25/2009 and 08/03/2009</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Detailed Action

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

The drawings filed on 5/25/06 have been approved by the Examiner.

Claim Objections

Claims 1-6,10-13 and 17 are objected to because of the following informalities:

In claims 1, 10 and 17, second occurrence "an external device" at last line should be changed to – the external device--.

In claims 2-6, 11-13, "an external device" at last line should be changed to – the external device--.

Appropriate correction is required.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 08/03/2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. However, the foreign references

(except WO 02/47352 A2) filed on 05/25/2006 fails to provide a English copy abstract,

and the foreign reference 2004-515863 fails to comply with 37 CFR 1.98(a)(1), which

requires the following: (1) a list of all patents, publications, applications, or other

information submitted for consideration by the Office, this reference 2004-515863 is not

in the list . The information disclosure statement has been placed in the application file,

but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. The claimed invention is directed to non-

statutory subject matter. Claim 17 is directed to a computer program, and a computer

program by itself is not statutory subject matter since a computer program is software,

the computer program itself is not a process and a claim for a computer program,

without the computer-readable storage medium needed to realize the computer

program's functionality is created as non-statutory functional descriptive material.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamada et al., US 2003/0135748 A1.

Regarding claim 1, Yamada teaches an information processing apparatus comprising:

a data processing block (it is taught as portable phone 40) for executing processing of downloading content and processing of transferring content to an external device (section 0051, 0056 and 0081-0085, section 0093-0095); and

a data storage block (it is taught as nonvolatile memory 410) for storing downloaded content (section 0059 and section 0079 and section 0085), wherein

said data processing block stores downloaded content into said data storage block (section 0059 and section 0079 and section 0085), holds a content identifier of downloaded content in a memory (section 0086), and, on the basis of said content identifier, identifies content subject to transfer to an external device (section 0092-0095).

Regarding claims 2 and 11, Yamada teaches said data processing block displays data with information about content transferable to an external device set as a list, sets an entry corresponding to downloaded content to said list, and executes a display operation with said entry set as transfer-specified content beforehand (section 0092).

Regarding claims 3 and 12, Yamada teaches said data processing block stores downloaded content into said data storage block (section 0059 and section 0079 and section 0085), acquires content from a data storage block on the basis of said content identifier of downloaded content held in said memory (section 0086), and transfers the acquired content to an external device (section 0092-0095).

Regarding claim 4, Yamada teaches said data processing block acquires content from a data storage block on the basis of said content identifier of downloaded content held in said memory and transfers the acquired content to an external device under a condition of a user transfer instruction input (section 0093 and section 0104).

Regarding claim 5, Yamada teaches said data processing block acquires content from a data storage block on the basis of said content identifier of downloaded content held in said memory and transfers the acquired content to an external device regardless of a user transfer instruction input (section 0103, last 5 lines).

Regarding claim 6, Yamada teaches said data processing block has a content management processing block for executing content download processing (it is taught as CPU within portable phone; section 0051,0056 and 0081-0085); a content transfer processing block for executing content transfer processing (it is taught as the combination of 401,402 and 403); and a music management block for storing content

into a data storage block and acquiring content from said music management block
(section 0048 and section 0103), said content management processing block outputs a
content identifier corresponding to downloaded content to said content transfer
processing block (Fig.2 and 6, section 0093-0095), and said content transfer processing
block outputs said content identifier to said music management block, acquires content
corresponding to said content identifier from said music management block, and
transfers the acquired content to an external device (section 0091-0097 and 0103).

Regarding claims 7 and 14, Yamada teaches said data processing block acquires
a content file name on the basis of a content identifier of downloaded content and
acquires a content file corresponding to content downloaded from a data storage block
on the basis of said content file name (section 0125, 0131, 0138 and section 0151).

Regarding claims 8 and 15, Yamada teaches said data processing block identifies
content to be written to an information recording medium on the basis of said content
identifier (section 0093-0095).

Regarding claims 9 and 16, Yamada teaches said data processing block displays
data with information about content writable to an information recording medium set as
a list, sets an entry corresponding to downloaded content to said list, and executing a
display operation with said entry set as write-specified content beforehand (section
0092-0095).

Regarding claims 10 and 17, Yamada teaches an information processing method for downloading content and transferring content to an external device, comprising:

a content storage step of executing process for storing downloaded content to a data storage block (section 0059 and section 0079 and section 0085); and

a transfer content identification step of holding a content identifier of downloaded content in a memory (section 0086), and, on the basis of said content identifier, executing process for identifying content subject to transfer to an external device (section 0092-0095).

Regarding claim 13, Yamada teaches further comprising: a step of detecting a user transfer instruction input (it is taught as any user of phone may use the selected data or program, section 0093 and 0104); and a content transfer step of acquiring content from a data storage block on the basis of said content identifier of downloaded content held in said memory under a condition of a user transfer instruction input to transfer the acquired content to an external device (section 0093 and section 0104).

When responding to the office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections. See 37 C.F.R. 1.111 (c).

When responding to the office action, Applicants are advised to provide the examiner with the line numbers and page numbers in the application and/or references cited to assist examiner to locate the appropriate paragraphs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine Song whose telephone number is 571-272-4213. The examiner can normally be reached on 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reginald Bragdon can be reached on 571-272-4204. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jasmine Song/

Primary Examiner, Art Unit 2189